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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
| 09/461,375 | 12/15/99 | GUERET | J 2350-76 |

HM22/0117

EXAMINER

CHOI, F

NIXON & VANDERHYE PC
1100 NORTH GLEBE ROAD 8TH FLOOR
ARLINGTON VA 22201-4714

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
| 1616 | 6 |

DATE MAILED: 01/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/461,375 | GUERET, JEAN-LOUIS | |
| Examiner | Art Unit | | |
| Frank I Choi | 1616 | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) Responsive to communication(s) filed on 06 November 2000.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 and 16 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9, 15 and 17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) All b) Some * c) None of the CERTIFIED copies of the priority documents have been:
1. received.
2. received in Application No. (Series Code / Serial Number) _____.
3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- | | |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I, claims 1-9, 15, 17 in Paper No. 5 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Accordingly, Claims 10-14, 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9, 15, 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for ethylhexyl acrylate/vinyl acetate/acrylic acid copolymer, nylon or polymethyl methacrylate powders, ethyl acetate, ethyl alcohol and/or isopropyl alcohol in the disclosed ranges does not reasonably provide enablement for non-ionic and non-water-swellable copolymers of acrylic/vinylic type, all fillers or organic solvents or having components per se without indicating amounts. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. According to the invention, the polymer must have a linear structure, be nonionic and non-water-swellable, however, other than for ethylhexyl acrylate/vinyl acetate/acrylic acid copolymer, there does not appear to be disclosed what combinations of the vinyl/acrylic type monomers would have these properties. The

Specification only lists two types of fillers, nylon and polymethyl methacrylate powders and three types of organic solvents. Further, there is a requirement that after evaporation the copolymer exhibit a specific adhesiveness. It is notoriously well known that the type of polymer and relative proportions of the other components in a composition can effect adhesiveness, however, the Specification appears to provide only limited examples of suitable combinations and amounts. Finally, there are numerous possible polymers, fillers and solvents and, thus, numerous combinations. As such, in light of the limited disclosure, a skilled artisan would be required to do undue experimentation in order to determine a suitable polymer, filler and solvent and amounts thereof and amounts of the other components, other than as specifically disclosed in the Specification, which would result in a composition having the claimed properties.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 15, 17 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that said claims fail to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 5 filed 11/6/00. In that paper, applicant has stated the compositions contain no water, and this statement indicates that the invention is different from what is defined in the claim(s) because the claims do not clearly indicate that they may not contain water.

Claims 1-9, 15, 17 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: linear structure of the polymer (Specification, pg. 3, lines 14, 15).

Art Unit: 1616

Conclusion

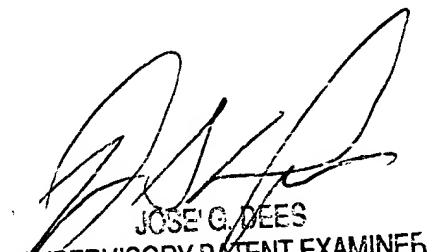
A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

FIC

January 12, 2001



JOSE G. DEES
SUPERVISORY PATENT EXAMINER
1616

